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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/195,368 11/18/98 ASHKENAZI

A 11669.26US03

EXAMINER

HM22/0228

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ART UNIT

PAPER NUMBER

1642

DATE MAILED:

02/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/195,368

Applicant(s)

ASHKENAZI ET AL.

Examiner

Gary B. Nickol Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 27-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 59 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 27-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

***Response to Amendment***

The Amendment filed December 11, 2000 (Paper No. 12) in response to the Office Action of June 7, 2000 is acknowledged and has been entered. Claims 1-2, and 9 have been amended. New Claims 27-59 have been added. Claims 1-9, and 27-59 are pending and are currently being examined.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.**

**Rejections Maintained**

**35 USC 102(e)**

Claims 1,3-9 remain rejected, and amended Claim 2 and new Claims 27-58 are rejected under 35 USC 102(e) as being anticipated by Yu et al. (US Patent No. 5998171, August 16, 1996) for the reasons of record in Paper No. 10, page 6. Further, all of the claims are drawn to isolated DNA *comprising* polynucleotides. The Yu et al. reference clearly anticipates such DNA comprising polynucleotides which encode the complete protein from amino acids 1-177 of SEQ ID NO:1 including encoding various fragments of SEQ ID NO: 1.

Applicant's argue (Paper No. 12, pages 7-8) that the Yu et al. patent cannot anticipate claims 1 or 3-9 because the Yu et al. patent disclosure is non-enabling. Applicant's argue that the patent provides structural information concerning endokine alpha, yet fails to teach one of

ordinary skill how to use such an endokine alpha polypeptide. Applicant's further argue that the patent provides no functional data to suggest how the endokine alpha polypeptide can be tested in cytotoxicity or proliferation assays. Essentially, applicant's argue, the disclosure within US Patent No. 5998171 fails to meet the requirements of either Section 112 or Section 101. This argument has been considered but is not found persuasive. Patents are relevant as prior art for all they contain, and once a patent has been issued it is considered valid and assumed to meet the requirements of 35 USC 112 and 101. Thus, Applicant's arguments have not been found persuasive and the rejection is maintained.

All other rejections are withdrawn in light of the amendments thereto.

#### **New Objections**

The specification is objected to for the following reason: The specification on page 1 should be amended to reflect the priority status of the present application, for example:

This application claims benefit to provisional application 60/065,635, filed November 11, 1997, now abandoned, and to provisional application 60/069,661, filed December 12, 1997, now abandoned.

#### ***Allowable Subject Matter***

Claim 59 is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


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Gary B. Nickol, Ph.D.  
Examiner  
Art Unit 1642

GBN  
February 23, 2001

  
GARY B. NICKOL  
PATENT EXAMINER  
TECHNOLOGY CENTER 1000